

13
UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

09/37874-124

05/22/00

ANDERSON

D

012712-855

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
--------------------	-------------	-----------------------	------------------

000909
PILLSBURY WINTHROP LLP
1600 TYSONS BOULEVARD
MCLEAN VA 22102

HM22/1106

GAMBEL, P

EXAMINER

1644

ART UNIT

PAPER NUMBER

1644

11/06301

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 10/12/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s) or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-26 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGE-

DETAILED ACTION

1. Applicant's communication, filed 10/19/01 (Paper No. 11), has placed this application in compliance with the Sequence Rules.

2. Prior to setting forth the restriction requirement, it is pointed out that the claims are drawn to patentably distinct products and methods which rely upon different ingredients, process steps and endpoints, which, in turn, require non-coextensive searches to such an extent that they are considered separately patentable. B7-1 and B7-2 exhibit pronounced differences in structural and functional characteristics and their role in costimulatory signal regulating T cell function is complex and distinct. Therefore, the restriction will be set forth for each of the various Groups, irrespective of the format of the claims, because these are not proper species.

Also, it is noted that claims 11-20 do not recite the B7.2 specificity, however it appears that applicant intends to claim methods of use comprising the administration of B7.2-specific antibody. Therefore, in the interest of compact prosecution, this Group has been set forth.

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-10 and 21-26, drawn to B7.1-specific antibodies and compositions thereof, classified in Class 530, subclass 387.1 and Class 424, subclass, 130.1.,

II. Claims 1 and 10 and 21-26, drawn to B7.2-specific antibodies and compositions thereof, classified in Class 530, subclass 387.1 and Class 424, subclass, 130.1.

III. Claims 11-20, drawn to treating diseases with B7.1-specific antibodies, classified in Class 424, subclass 143.1

IV. Claims 11-20, drawn to treating diseases with B7.2-specific antibodies, classified in Class 424, subclass 153.1.


It is noted that claims 11-20 do not recite the B7.2 specificity, however it appears that applicant intends to claim methods of use comprising the administration of B7.2-specific antibody. Therefore, in the interest of compact prosecution, this Group has been set forth.

4. Inventions (I and III) and (II and IV) are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the antibodies as claimed can be used in a materially different process such as affinity purification procedures, detection assays or in vitro bioassays or screening procedures.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.


Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
November 5, 2001